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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/065,787	04/23/1998	RODNEY GLEN ADAMS	17275-P043US	7960

21909 7590 07/02/2003

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ART UNIT	PAPER NUMBER
2662	17

DATE MAILED: 07/02/2003

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 17

Application Number: 09/159,734

Filing Date: September 24, 1998

Appellant(s): WADE, ROY

Theodore F. Shiells
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 14 April 2003.

(1) Real Party in Interest.

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement concerning the status of the amendments after final is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The appellant's grouping of the claims in the brief is correct.

(8) ClaimsAppealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The appellant's statement that the prior art of record is Brown and Hyde-Thomson is correct.

(10) Grounds of Rejection

Claims 1, 6, 11-13, 15-18, 20-22, 30, 31, 33, 35, 36, 39, and 42 are rejected under 35

U.S.C. 103(a) as being unpatentable over Brown in view of Hyde-Thomson. Brown discloses an apparatus and method for providing translation services to telecommunications processes for sending an information message over the Internet to an unknown address of a recipient when a unique identifier for the recipient is known (abstract; column 2, lines 56-61). The method comprises the steps of receiving an e-mail message which includes the information message and a unique identifier of the recipient; extracting the identifier from the message and querying a directory server for the address (such as the e-mail address) of the recipient; receiving the address as a response to the query; inserting the address into the information message; and forwarding the resulting message over the Internet (column 2, line 62 to column 3, line 11). A service provider performs these steps, and according to an embodiment the messages are received from the Internet (column 3, lines 17-31). According to an embodiment, a voice messaging system and an e-mail host are used. A telephone subscriber uses the voice messaging system (VMS) to create a voice message. The recipient of the voice message is identified using a telephone number. The VMS converts the voice message to an e-mail format such as SMTP, which is a data network format. The VMS then addresses the message and forwards it over the Internet to the SMTP host of the service provider. Upon receiving the message, the SMTP host passes it to an application process that stores it in memory and receives the address from the directory server as described above. Upon receiving the e-mail address, the SMTP host sends the translated voice message to the recipient's e-mail mailbox (column 4, lines 30-46; column 4, line 53 to column 5, line 7). The invention inherently involves push technology because no action on the part of the recipient is required for delivery of the message to the recipient's mailbox. Brown

fails to teach that the e-mail address of the recipient is known by the sender and is the unique identifier. Hyde-Thomson teaches a message handling system in which a voice message is converted to a digital voice file, which is stored in a shared memory device corresponding to the intended recipient's mailbox (abstract). A user can use standard e-mail message software (column 3, lines 54-57). It has been well known in the art that one specifies the e-mail address of the recipient of an e-mail message, when one uses standard e-mail message software. A voice gateway PC records and digitizes the user's voice message, and attaches the digitized voice file to a text e-mail file. It would have been obvious to one of ordinary skill in the art to modify the invention of Brown so that the e-mail address is known by the sender and is the unique identifier b, as in Hyde-Thomson, because e-mail addresses are oftentimes easy for users to remember and specifying the e-mail address by the user would reduce network traffic.

Claims 2, 7, 14, 19, 32, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown and Hyde-Thomson, as applied to claims 1, 6, 13, 17, and 30 above, and further in view of Burg. Brown and Hyde-Thomson fail to teach that the called party is notified of the incoming call. Burg discloses an apparatus and method which allow a called party to connect to a data network using a telephone transmission line (abstract). If the called party's computer is logged into the network, a telephony gateway notifies the called party of the incoming call; the format and content of the received message, as well as options for handling the call, are provided to the called party (column 4, line 66 to column 5, line 16; column 8, lines 38-42). The transmission of the notification is inherently nearly simultaneous with the transmission of the translated voice message if the recipient is logged onto the network. This type of notification is by definition a page, and it is a short message. It would have been obvious to one of ordinary

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skill in the art to modify the inventions of Brown and Hyde-Thomson so that the called party is informed when an incoming call arrives, and the called party is informed of the format and options for handling the call, as in Burg, because such an arrangement allows the caller and called party to communicate as soon as either party desires to communicate, which is the primary motivation for converting voice into e-mail.

Claims 3-5, 8-10, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, Hyde-Thomson, and Burg, as applied to claims 2, 7, and 32 above, and further in view of Emery et al.

With regard to claims 3, 8, and 41, neither Brown nor Hyde-Thomson nor Burg teaches the option of using a wireless network. Emery et al. discloses a system and method in which an advanced intelligent network (AIN) wireline system connects to and controls processing of calls to a personal communication service subscriber's wireless communication network (abstract).

Examiner takes Official Notice that the sending of notifications as pages or short message service messages has been well known in the art. It would have been obvious to one of ordinary skill in the art to modify the inventions of Brown, Hyde-Thomson, and Burg so that they use wireless communication networks, as in Emery et al., because such an arrangement would provide a communication service that is adaptable to each user's individual lifestyle.

With regard to claims 4, 5, 9, and 10, neither Brown nor Hyde-Thomson teaches the sending of notifications in the form of pages or short message service messages. Burg discloses an apparatus and method that allow a called party to connect to a data network using a telephone transmission line (abstract). If the called party's computer is logged into the network, a telephony gateway notifies the called party of the incoming call; the format and content of the received

message, as well as options for handling the call, are provided to the called party (column 4, line 66 to column 5, line 16; column 8, lines 38-42). This type of notification is by definition a page, and it is a short message. It would have been obvious to one of ordinary skill in the art to modify the inventions of Brown and Hyde-Thomson so that the called party is informed when an incoming call arrives, and the called party is informed of the format and options for handling the call, as in Burg, because such an arrangement allows the caller and called party to communicate as soon as either party desires to communicate, which is the primary motivation for converting voice into e-mail.

Claims 23-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Hyde-Thomson, Burg, and Emery et al. Brown discloses an apparatus and method for providing translation services to telecommunications processes for sending an information message over the Internet to an unknown address of a recipient when a unique identifier for the recipient is known (abstract; column 2, lines 56-61). The method comprises the steps of receiving an e-mail message which includes the information message and a unique identifier of the recipient; extracting the identifier from the message and querying a directory server for the address (such as the e-mail address) of the recipient; receiving the address as a response to the query; inserting the address into the information message; and forwarding the resulting message over the Internet (column 2, line 62 to column 3, line 11). A service provider performs these steps, and according to an embodiment the messages are received from the Internet (column 3, lines 17-31). According to an embodiment, a voice messaging system and an e-mail host are used. A telephone subscriber uses the voice messaging system (VMS) to create a voice message. The recipient of the voice message is identified using a telephone number. The VMS converts

the voice message to an e-mail format such as SMTP. The VMS then addresses the message and forwards it over the Internet to the SMTP host of the service provider. Upon receiving the message, the SMTP host passes it to an application process that stores it in memory and receives the address from the directory server as described above. Upon receiving the e-mail address, the SMTP host sends the translated voice message to the recipient's e-mail mailbox (column 4, lines 30-46; column 4, line 53 to column 5, line 7).

Brown fails to teach that the e-mail address of the recipient is known by the sender and is the unique identifier; Brown fails to teach that the called party is notified of the incoming call; and Brown fails to teach the option of using a wireless network.

Hyde-Thomson teaches a message handling system in which a voice message is converted to a digital voice file, which is stored in a shared memory device corresponding to the intended recipient's mailbox (abstract). A user can use standard e-mail message software (column 3, lines 54-57). It has been well known in the art that one specifies the e-mail address of the recipient of an e-mail message, when one uses standard e-mail message software. A voice gateway PC records and digitizes the user's voice message, and attaches the digitized voice file to a text e-mail file. Burg discloses an apparatus and method that allow a called party to connect to a data network using a telephone transmission line (abstract). If the called party's computer is logged into the network, a telephony gateway notifies the called party of the incoming call; the format and content of the received message, as well as options for handling the call, are provided to the called party (column 4, line 66 to column 5, line 16; column 8, lines 38-42). The transmission of the notification is inherently nearly simultaneous with the transmission of the translated voice message if the recipient is logged onto the network. This type of notification is

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by definition a page, and it is a short message. Emery et al. discloses a system and method in which an advanced intelligent network (AIN) wireline system connects to and controls processing of calls to a personal communication service subscriber's wireless communication network (abstract).

It would have been obvious to one of ordinary skill in the art to modify the invention of Brown so that the e-mail address is known by the sender and is the unique identifier, as in Hyde-Thomson, because e-mail addresses are oftentimes easy for users to remember and specifying the e-mail address by the user would reduce network traffic. It would have been obvious to one of ordinary skill in the art to modify the invention of Brown so that the called party is informed when an incoming call arrives, and the called party is informed of the format and options for handling the call, as in Burg, because such an arrangement allows the caller and called party to communicate as soon as either party desires to communicate, which is the primary motivation for converting voice into e-mail. It would have been obvious to one of ordinary skill in the art to modify the invention of Brown so that it uses a wireless communication network, as in Emery et al., because such an arrangement would provide a communication service that is adaptable to each user's individual lifestyle.

Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brown and Hyde-Thomson, as applied to claim 30 above, and further in view of Finnigan. Brown and Hyde-Thomson fail to teach a certification means. Finnigan discloses a voice message store and forward service in which notification of success or failure of the message transfer is provided (column 2, lines 38-42; column 9, lines 40-53; claim 2). It would have been obvious to one of ordinary skill in the art to modify the inventions of Brown and Hyde-Thomson so that

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certification is provided, as in Finnigan, because certification provides proof of receipt of the message.

Claims 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown and Hyde-Thomson, as applied to claim 31 above, and further in view of the Admitted Prior Art. Brown and Hyde-Thomson fail to teach the use of means for recognizing touch tone codes as representing network addresses. The Admitted Prior Art teaches that an established prior art protocol may be used to enter an address using the touch tone keys (page 8, lines 8-10). It would have been obvious to one of ordinary skill in the art to modify the inventions of Brown and Hyde-Thomson so that the identifier is entered using touch tones because such an arrangement would allow callers to easily and quickly provide the address of the recipient using a readily available touch tone telephone.

(11) Response to Argument

In appellant's argument, appellant only addressed the prior art Brown and Hyde-Thomson. The appellant argues that the fact that "e-mail addresses are oftentimes easy for users to remember" is not found in the prior art of record. But all that is necessary is that this fact would have been obvious to one of ordinary skill in the art.

The appellant argues that the modification of Brown using Hyde-Thomson would not have been obvious because the modification would have certain disadvantages. But whether disadvantages exist is irrelevant to a 103(a) rejection (assuming, of course, that they do not involve either inoperability or a significant change in principle of operation); what matters is whether the modification would have been obvious because of the resulting advantages.

The appellant argues that inputting an e-mail address without using a computer is contrary to conventional wisdom. But the claims nowhere teach that no computer is used.

The appellant argues that omission of steps in the claims renders the claims non-obvious. But the claims do not specify that the steps are indeed omitted.

The appellant states that the claimed invention omits certain elements retained in the prior art of record. But the claims nowhere state that these elements are omitted.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Joe Logsdon

Friday, June 27, 2003

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